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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,766	12/20/2001	Tony Piotrowski	US010629	4307

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EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/024,766	Applicant(s) PIOTROWSKI, TONY	
	Examiner Calvin L. Hewitt II	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-18 have been examined.

Response to Arguments/Amendments

2. Claims 1 and 9 have been amended to include the language of an e-receipt including information that is "derived from sources other than the associated merchant", while claim 14 has been amended to recite "may be derived from sources other than the associated merchant". However, this language is not supported by Applicant's Specification. Webster's Ninth New Collegiate Dictionary defines "derive" as "to take or receive from a specified source". According to Applicant's Disclosure, the e-receipt is provided to the e-receipt device (figure 2, item 200) by an associated merchant (figure 2, item 100) (page 7, lines 8-15; page 9, lines 5-15), that is to say the e-receipt is derived from the associated merchant, which contradicts Applicant's claim 9. Claim 14 is directed to an apparatus, and it has been held that although there is nothing inherently wrong in defining something by what it does (*In re Hallman* 210 USPQ 609) and features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished in terms of structure rather than function (MPEP 2114; *In re Schreiber* 44 USPQ2d 1429

(1997). Hence, the function of the purchaser's controller being *operable* to do something does not differentiate the claim from the prior art. Claim 14 also recites information that "may be" derived from sources other than an associated provider. On the other hand, the MPEP clearly states that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2100-8, first column). Hence, the source of the information does distinguish Applicant's claims from the prior art. Claim 1 recites "for confirming the purchaser has paid for and is entitled to receive from an associated merchant goods and/or services", however this is taught by Husemann et al., as a ticket taker provides the goods and/or services while a ticket provider provides the information that confirms that the purchaser is entitled to receive said goods and services (column/line 3/55-4/15). Claim 1 is directed to an apparatus, but the amended claims further describe the information. Hence, as the information is not part of the apparatus' structure it does not further limit the apparatus. Applicant's "communication unit", "purchaser's controller" and "merchant tag reader" [claim 1] are defined by intended use language (e.g. "for", "configured", "capable"), therefore, as it has been held that a claimed apparatus described by its intended use does not distinguish the apparatus from the prior art (MPEP 2114; *Ex parte Masham*, 2 USPQ2d 1647 (1987)) the aforementioned features of

the apparatus of claim 1 is not differentiated from the teachings of Husemann et al. and Wynn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

According to Applicant's Disclosure, the e-receipt is provided to the e-receipt device (figure 2, item 200) by an associated merchant (figure 2, item 100) (page 7, lines 8-15; page 9, lines 5-15), that is to say the e-receipt is derived from the associated merchant, which contradicts Applicant's claim 9.

Claims 10-13 are also rejected as they depend from claim 9.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8, 10, 11, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed to an apparatus comprising a merchant tag reader. The claim, however, does not coincide with Applicant's Specification. For example, Applicant discloses a first apparatus comprising a programmable tag, communication unit, and controller (Specification, figure 3) and a second apparatus comprising a merchant tag reader (Specification, page 8, lines 12-18). Therefore, it is not clear to one of ordinary skill the structure of the apparatus as defined by claim 1 ("An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous", *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Claims 2-8 are also rejected as they depend from claim 1.

Claim 10 recites the limitation "the information" in line 2, however, it is not clear to one of ordinary skill whether the information is the e-receipt information (claim 9, lines 10-12) or related information (claim 9, lines 24-26). Claims 11, 15 and 16 are also rejected as each contains similar language "the information".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3621

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Husemann et al., U.S. Patent No. 6,192,349 and Wynn, U.S. Patent No. 5,859,419.

As per claims 1, 3, 5, 9, 10 and 14 Husemann et al. teach an apparatus comprising:

- a transportable and detachable programmable tag (figure 2; column 4, lines 9-15)
- a communication unit (figure 3; column 3, lines 14-21)
- a purchaser's controller coupled to the tag and the communication unit (figures 1 and 3) and receives information from an information interface via the communication unit (figure 1)
- a merchant's tag reader (figure 5; column 4, lines 9-15)
- receiving a request to complete a transaction for goods and services over the internet and completing the transaction (column 3, lines 22-28)
- providing an e-receipt to the purchaser (figure 1; column 3, lines 22-28) and using e-receipt [unique code] information to program the tag (figure 1; column/line 3/22-4/8)

- presenting the tag to a merchant reader and the merchant determining whether or not the purchaser should receive the good and/or service (column 4, lines 10-15; column/line 5/1-6/7)
- recording information related to the transaction and the e-receipt (column 4, lines 60-65)

However, Husemann et al. do not specifically recite uniquely associating the tag with an individual purchaser. Wynn teaches a programmable RFID tag that is uniquely identified with a purchaser (column/line 4/55-5/5; column 14, lines 47-50; column/line 20/50-21/6). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Husemann et al. and Wynn in order to protect private data stored on the programmable tag using a PIN ('419, column 14, lines 47-50).

As per claims 2, and 6-8 it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of function alone (MPEP 2114 and *Ex Parte Masham*, 2 USPQ2d 1647 (1987)).

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Husemann et al., U.S. Patent No. 6,192,349 and Wynn, U.S. Patent No. 5,859,419 as applied to claim 1 above and in further view of Lofgren et al., U.S. Patent No. 6,660,911.

As per claim 4, Husemann et al. teach a programmable tag, such as a smart card (figure 2). Wynn teaches a programmable RFID tag (column 4, lines 45-54). However, neither Husemann et al. nor Wynn specifically recite a programmable identification card that comprises a bar code. Lofgren et al. teach a programmable identification card that comprises a bar code (column 12, lines 5-10). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Wynn and Lofgren et al. in order to assist in authenticating the card and/or the card-holder ('911, column 3, lines 35-40).

9. Claim 11-13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Husemann et al., U.S. Patent No. 6,192,349 and Wynn, U.S. Patent No. 5,859,419 as applied to claim 1 above and in further view of Veil et al., U.S. Patent No. 6,092,202.

As per claims 11-13 and 16-18, Husemann et al. teach a method for determining whether a purchaser is entitled to receive goods and services associated with an e-receipt by determining the validity of an e-receipt stored on a programmable tag (abstract; column 2, lines 22-30). Specifically, Husemann et al. provide an e-receipt that comprises information related to a tag's [public and private] identity. Husemann et al. also create a database that is used to verify what goods and services are associated with an e-receipt (column 3, lines 61-65;

column 4, lines 45-47; column/line 5/1-6/7) and consumer profile (column 3, lines 22-41 and 61-65). Wynn teaches a programmable tag comprising an RFID tag (column 4, lines 45-54). However, neither Husemann et al. nor Wynn specifically disclose information that includes data related to a purchaser's identity. Veil et al. disclose a programmable tag with public and private identity such as a user public and private key (abstract; figure 2A; column/line 4/45-5/10; column 6, lines 3-11; column 11, lines 23-28). Therefore, it would have been obvious to combine the teachings of Husemann et al., Wynn and Veil et al. in order to provide a more secure system by not only verifying the e-receipt but also the purchaser by requiring a PIN to initiate a transaction ('202, column 11, lines 53-65; column 12, lines 4-14)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
 - Stone et al. teach a purchaser gaining access to venue using other data (e.g. credit card number) besides a ticket.
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 3600

Washington, D.C. 20231

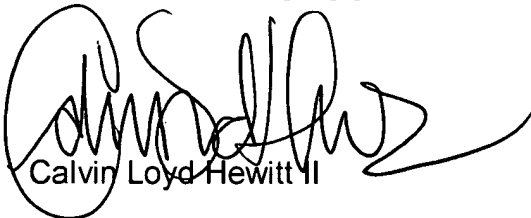
or faxed to:

(571) 273-8300 (for formal communications intended for entry and
after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")



Calvin Loyd Hewitt II

February 17, 2006